

REMARKS/ARGUMENTS

This paper is submitted in response to the final Office Action mailed November 10, 2005. In the Office Action, the Examiner rejected claims 1-3 under 35 U.S.C. §103(a) as being obvious over Admitted Prior Art (hereinafter "APA") in view of U.S. Patent No. 6,491,781 to Kreckel et al. (hereinafter "Kreckel") and U.S. Patent No. 6,610,386 to Williams et al. (hereinafter "Williams").

In view of the following remarks, immediate allowance of claims 1-3 is respectfully requested.

Rejection of Claims 1-3 under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1-3 under 35 U.S.C. §103(a) as being obvious over APA in view of Kreckel and Williams. In the final Office Action, the Examiner asserted on page 3, section 4 that:

[T]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; *nor is it that the claimed invention must be expressly suggested in any one or all of the references*. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(Emphasis added).

Applicants respectfully submit that the Examiner has misstated the test for obviousness and thus, has failed to establish the *prima facie* obviousness of claims 1-3. MPEP §2143 expressly states that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, MPEP § 2143.03 expressly states that "To establish prima facie obviousness of a claimed invention, all the claim limitations *must* be taught or suggested by the prior art." *Citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)(emphasis added).

Applicants respectfully assert that the *prima facie* obviousness of claims 1-17 has not been established because APA, Kreckel, and Williams, either singly or in combination, do not teach or suggest all of the elements of claims 1-3 and that there is insufficient motivation to combine APA with Kreckel and Williams.

First, independent claim 1 recites "removing a selected portion of said transferable material to obtain a hollowed transferable material with a specific pattern vacancy; and adhering the remaining transferable material onto said light transmissible surface of said article." Claims 2 and 3 depend from claim 1 and thus, also include these claim elements.

In contrast, APA does not teach or suggest removing a selected portion of said transferable material to obtain a hollowed transferable material with a specific pattern vacancy or adhering the remaining transferable material onto said light transmissible surface of said article. Instead, APA teaches that "for transfer-printing a personalized image such as signatures, favorite signs or handwritings, the desirable image should be printed in advance by the manufacturers." Specification, paragraph [0005]. Once the discrete images are printed, they are then "adhered to the target article one by one by applying a depressing force to the other surface 111 of the transparent film substrate 11 at each of the corresponding positions of the selected" discrete images. Specification, paragraph [0004]. In other words, each letter is removed from the transferable layer to spell a word, not to obtain a hollowed transferable material with a specific pattern vacancy. In fact, the remaining letters on the transferable layer have no meaning or value in combination and thus, would not be adhered to the article's surface. Consequently, this method disclosed in APA does not teach or suggest "removing a selected portion of said transferable material *to obtain a hollowed transferable material with a specific pattern vacancy*

and adhering the *remaining transferable material* onto said light transmissible surface of said article” as provided in claims 1-3. (Emphasis added).

Similarly, Kreckel fails to teach or suggest “removing a selected portion of said transferable material *to obtain a hollowed transferable material with a specific pattern vacancy* and adhering the *remaining transferable material* onto said light transmissible surface of said article” as provided in claims 1-3 and the Examiner did not assert that Kreckel teaches or suggests this claim language. (Emphasis added). Instead, Kreckel is directed to “An adhesively mountable image using a highly tacky reusable adhesive surface.” Kreckel, Abstract.

Likewise, Williams fails to teach or suggest “removing a selected portion of said transferable material *to obtain a hollowed transferable material with a specific pattern vacancy* and adhering the *remaining transferable material* onto said light transmissible surface of said article” as provided in claims 1-3 and the Examiner did not assert that Williams teaches or suggests this claim language. (Emphasis added). Instead, Williams is directed to “a transferable support ... having on a surface thereof encoded data in the form of dot code or two-dimensional bar code wherein the data is capable of being read by a sensor.” Williams, Abstract.

Consequently, neither APA, Kreckel, nor Williams, singly or in combination, teaches or suggests “removing a selected portion of said transferable material *to obtain a hollowed transferable material with a specific pattern vacancy* and adhering the *remaining transferable material* onto said light transmissible surface of said article.” (Emphasis added). Thus, APA in view of Kreckel and Williams does not teach or suggest all the elements of claims 1-3. Therefore, the Examiner has failed to establish the *prima facie* obviousness of claims 1-3.

Second, there is insufficient motivation to combine APA with Kreckel and Williams. MPEP §2143.01(III) states that “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *Citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In this case, the Examiner has not provided any suggestion of the desirability of the combination of APA with Kreckel and Williams.

Further, MPEP § 2143.01(V) states that “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion

or motivation to make the proposed modification.” *Citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, MPEP § 2143.01(VI) provides that “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *Citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In this case, transferable layer of APA comprises discrete images, letters of the alphabet, which each operate to provide distinct meaning and may be combined to spell a word when individually removed from the transferable layer and attached to a surface. Similarly, the discrete image of Williams is encoded data in the form of dot code or two-dimensional bar code that is capable of being read by a sensor. The Examiner proposes replacing the discrete images of APA with the encoded data image of Williams. However, this proposed combination would change the principle of operation of both APA and Williams and render both APA and Williams unsatisfactory for their intended purpose.

Specifically, if any part of the dot code or two-dimensional bar code were removed to obtain a hollowed transferable material with a specific pattern vacancy as suggested by the Examiner, the removed transferable material and the remaining transferable material would no longer contain data or have any meaning. Instead, the removed and remaining transferable material would provide incomprehensible gibberish and would be meaningless. Consequently, the combination of APA and Williams as suggested by the Examiner would change the principle of operation of APA and Williams. Further, APA and Williams would be unsatisfactory for their intended purpose of conveying data and meaning. Consequently, there is insufficient motivation to make the proposed modification.

Because neither APA, Kreckel, nor Williams, singly or in combination, teaches or suggests all the elements of claims 1-3 and because there is insufficient motivation to combine APA with Kreckel and Williams as suggested by the Examiner, the Examiner has failed to establish the *prima facie* obviousness of claims 1-3. Therefore, Applicants respectfully requests that this rejection be withdrawn.

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Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "E. R. Witt", is written over a horizontal line.

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